

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the discussion presented herein.

1. **Restriction requirement.**

(a) The Examiner contends that the application contains claims directed to patentably distinct inventions; that is Claims 1-32 are drawn to an underground utility locating and marking apparatus, and Claim 33 is drawn to a method of locating and marking an underground utility and can be practiced by at least two, materially different apparatuses. Accordingly, an election has been required.

In response, the Applicant provisionally elects Invention 1: Claims 1-32 and withdraws Claim 33 subject to the provisions of 37 CFR 1.141 with regard to consideration of claims drawn to an additional species once generic claims are allowed. Claims 1-2 and 5-11 are generic.

This election is made with traverse.

(b) The Examiner contends that the application contains claims directed to patentably distinct species; that is, the species described in paragraph 0015 (symbol painting apparatus), the species described in paragraph 0016 (spike marking apparatus), and the species described in paragraph 0027(symbol painting and spike marking apparatus). Accordingly, an election has been required.

In response, the Applicant provisionally elects the species as described in paragraph 0016 (symbol painting apparatus). Claims 1-3, 5-12, 15-18, and 28-29 read on the elected species. Claims 1-2 and 5-11 are generic.

Claims 4, 13, 19-22, and 30-31 read on the non-elected species of paragraph 0016 (spike marking apparatus). Claims 14, 23-27, and 32 read on the non-elected species of paragraph 0027 (symbol painting and spike marking apparatus).

The Applicant elects with traverse and withdraws Claims 4, 13-14, 19-27, and 30-32 subject to the provisions of 37 CFR 1.141 with regard to consideration of claims drawn to an additional species once generic claims are allowed.

2. Traversal of Species Election Requirement.

(a) The Examiner contends that the application contains claims directed to patentably distinct species; that is, the species described in paragraph 0015 (symbol painting apparatus), the species described in paragraph 0016 (spike marking apparatus), and the species described in paragraph 0027(symbol painting and spike marking apparatus).

In response, the Applicant respectfully traverses the Examiner's contention. The invention is an underground utility locating and marking apparatus. For example, certain underground utilities are positioned under both pavement and under unpaved earth, such as an underground pipeline beneath a road crossing under an undeveloped lot. An embodiment of the elected species (symbol painting apparatus) can employ an additional (spike marking) system for use when the utility is positioned under terrain where symbol painting is unsuitable. This feature is not mutually exclusive but adds capability to the invention. Further, the third species (symbol painting and spike marking apparatus) is capable of performing its intended function of locating and marking an underground utility if the symbol marking system or the spike marking system is temporarily removed from the apparatus in anticipation of the nature of the surface to be marked.

Accordingly, the Applicant respectfully requests that the Examiner remove the restriction with regard to embodiments described in paragraphs 0016 and 0027 and with regard to Claim 33 in the next office action.

3. Election Made Without Prejudice or Estoppel.

Notwithstanding the election made and accompanying remarks provided above, Applicants do not acquiesce in the original ground for election with respect to the original form of these claims. The election has been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed. Applicants reserve the right to pursue the original scope of non-elected claims in the future, such as through a

Appl. No.: 10/616,861
Amdt. Dated: 01/08/2007
Off. Act. Dated: 12/11/2006

divisional application, for example.

4. Conclusion.

In the event any further matters remain at issue with respect to the present application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Dated: 01/08/2007

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John P. O'Banion". The signature is written in dark ink and is positioned above the printed name and address.

John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010